

**AMENDMENTS TO THE DRAWINGS**

The attached sheet(s) of drawings includes changes to Figures 1-4. More specifically, the scale of Figures 1-4 have been enlarged, as requested by the Examiner.

Attachment: Replacement sheets

### **REMARKS**

Applicant has carefully reviewed the Office Action mailed April 8, 2009, and thanks Examiner Binda for the detailed review of the pending claims. In response to the Office Action, Applicant has amended claim 1. Claims 18-25, 30 and 31 were previously withdrawn. By way of this amendment, no new matter has been added. Accordingly, claims 1-32 remain pending in this application. At least for the reasons set forth below, Applicant respectfully traverses the foregoing rejections.

As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such assertions/requirements in the future. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicant expressly does not acquiesce to the taking of Official Notice, and respectfully requests that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03. Applicant respectfully requests reconsideration of the present application in view of the above amendment, and the following remarks.

### **Election/Restrictions**

In the office action, the Examiner acknowledged Applicant's traversal of the election/restriction. As specifically pointed out by the Applicant in the traversal, a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship amount the inventions that involves "at least one common or corresponding special technical feature." As acknowledged by the Examiner, independent claim 1, the sole independent claim, as well as dependent claims 11-13, 15-17, 26-29 and 32 are generic among the species. Thus, by definition, these claims have a "technical relationship that involves at least one common or corresponding special technical feature,"

But more importantly, under the Unity of Invention standards, the Examiner bears the burden of clearly specifying *why* the claims directed to different groups of inventions lack a common special technical feature. In the election/restriction requirement, the Examiner offered no rationale for the election/restriction, instead just simply stating that the species “are no so linked as to form a single general inventive concept under PCT Rule 13.1.” As the presence of generic claims make clear that the claims of the different species have a “technical relationship that involves at least one common or corresponding special technical feature,” Applicant respectfully requests reconsideration of the election/restriction requirement.

### **Drawings**

The Examiner objected to the drawings because Reference numeral 29 appears in the drawings, but is not mentioned in the specification. To address the Examiner’s objection, paragraph [0028] has been amended to add reference numeral 29 thereto. Withdrawal of the objection is therefore requested.

The Examiner has also objected to the drawings, stating that he is unable to clearly see the limitations of claim 1, lines 14+, as well as claims 11, 26-29 & 32. To accommodate the Examiner’s request, Applicant has enlarged the scale of Figures 1-4 and has submitted replacement sheets accordingly. Withdrawal of the objection is therefore requested.

### **Specification**

The Examiner objected to the detailed description of the invention for allegedly failing to provide proper antecedent basis for the subject matter of claims 12, 13, 15-17, and 32. Applicant respectfully traverses the rejection.

Contrary to the Examiner’s assertion, paragraph [0014] as originally filed, discloses the subject matter of claims 12 and 13 (“the stop sleeve comprises an outer diameter which is smaller than the smallest inner diameter of the profiled sleeve in the region of the ball grooves.”). However in the interest of furthering prosecution, Applicant also proposes an amendment to the specification

to add paragraph [0029A] to address the Examiner's objection. Accordingly, withdrawal of the objection is requested.

With respect to claims 15-17, paragraph [0016] of the originally filed specification, as well as paragraph [0028] discloses the subject matter of these claims. More specifically, paragraph [0028] recites: "the stop sleeve 13, by a first end 14, is supported on the ball hub 4, . . . The stop sleeve 13 thus prevents the ball cage 10 from moving out of its position shown in Figure 1 towards the end 3 of the profiled journal 1, as a result of which the balls 11 at the joint end of the ball cage are prevented from running into the ball groove run-out." However, in the interest of furthering prosecution, Applicant also proposes an amendment to the specification to amend paragraph [0028] to address the Examiner's objection. Accordingly, withdrawal of the objection is requested.

With respect to claim 32, paragraph [0020] of the originally filed specification discloses the subject matter of this claim. More specifically, paragraph [0020] recites "The stop sleeve is preferably made of plastics or metal." However, in the interest of furthering prosecution, Applicant also proposes an amendment to the specification to add paragraph [0029B] to address the Examiner's objection. Accordingly, withdrawal of the objection is requested.

### **Claim Rejection – 35 U.S.C. § 102**

#### **1. The Law**

To anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

**2. FR 1.373.752 to Spicer**

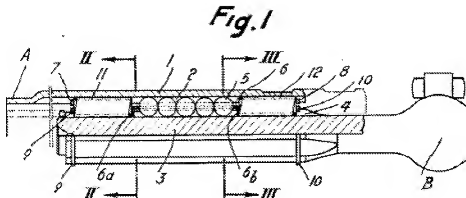
Claims 1, 11-13, 15-17, 26-29 and 32 were rejected under 35 U.S.C. § 102(b) as being anticipated by FR 1.373.752 to Spicer (“Spicer”). Applicant respectfully traverses the rejection.

**1. Independent Claim 1**

Independent claim 1 positively recites “an abutment sleeve on the profiled journal.” In addition, claim 1 has also been amended to recite that “wherein the abutment sleeve abuts the profiled journal or said component connected thereto with an axial distance from the ball groove run-outs in a region of the second portion of the profiled journal.” Support for this amendment may be found in at least paragraphs [0012], [0017], and [0028].

Claim 1 is patentable over Spicer as there are several limitations in claim 1 that are not present in Spicer. Indeed, contrary to claim 1, which expressly requires “an abutment sleeve on the profiled journal,” Spicer has no such structure. The claimed abutment sleeve delimits the displacement path of the ball cage to permit production of an annular groove axially adjacent to the ball grooves run-outs in a second portion of the profiled journal in a continuous cut, thereby reducing tool wear (see, e.g., [0012]). With this configuration, the balls are prevented from abutting the ball groove run-outs.

Turning specifically to Spicer, as shown below in reproduced FIG. 1, Spicer discloses spiral springs 11, 12 (see Attachment B, French – English translation of “resorts”) that are disposed between the ball cage 6 and respective outer securing rings 7 and 8. The springs 11, 12 are arranged in the outer ball groove 2 and the inner ball groove 4, respectively.



A spring is clearly not the claimed abutment sleeve that is disposed on the profiled journal as claimed in independent claim 1. For this reason alone, claim 1 is patentable over Spicer.

Moreover, claim 1 also positively recites that the claimed abutment sleeve abuts the profiled journal, or a component connected thereto, with an axial distance from the ball groove run-outs in a region of the second portion of the profiled journal. This feature is also not shown in Spicer. Instead, referring back to FIG. 1 of Spicer reproduced above, the securing ring 10 against which the spring 12 axially stops, is arranged within the axial region of the ball groove 4 of the profiled journal 3. Thus, Spicer fails to teach, suggest or disclose an abutment sleeve which is arranged on the profiled journal and which is axially supported in a region of the second portion of the profiled journal with an axial distance to the ball groove run-outs. If anything, Spicer teaches away from the claimed construction in that it teaches a securing ring 10 arranged in the region of the ball grooves 4. For at least this second reason, claim 1 is patentable over Spicer. Accordingly, withdrawal of the rejection is respectfully requested.

## 2. Dependent Claims 11-13, 15-17, 26-29 AND 32

Claims 11-13, 15-17, 26-29 and 32 are in condition for allowance at least because they depend from patentable independent claim 1. Further, the dependent claims also recite independently patentable subject matter. Accordingly, withdrawal of the rejection is respectfully requested.

**Claim Rejection – 35 U.S.C. § 103**

**1. The Law**

"To establish prima facie obviousness of a claimed invention, all the claim recitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

**2. Spicer**

Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over Spicer. Applicant respectfully traverses the rejection.

Claim 14 depends from independent claim 1. The remarks presented above with respect to the §102 rejection are equally applicable here. Specifically, the inadequacy of Spicer to teach every element of independent claim 1 by not teaching either "an abutment sleeve on the profiled journal," or that "the abutment sleeve abuts the profiled journal or said component connected thereto with an axial distance from the ball groove run-outs in a region of the second portion of the profiled journal," is also fatal to the Examiner's §103 rejection. Accordingly, for at least this reason, claim 14 is patentable over Spicer. Withdrawal of the rejection is respectfully requested.

**CONCLUSION**

In view of the above amendment and remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 66967-0033 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

Dated: July 8, 2009

Respectfully submitted,

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Attachments